PATENT
Docket No.: **19603/3243 (CRF D-2601C)**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Collmer et al.	Examiner: L. Mayes
Serial No.	:	09/825,414	Art Unit: 1653
Cnfrm. No.	:	2043	
Filed	:	April 3, 2001	
For	:	DNA MOLECULES AND POLYPEPTIDES OF *PSEUDOMONAS SYRINGAE* HRP PATHOGENICITY ISLAND AND THEIR USES	

RESPONSE UNDER 37 C.F.R. § 1.111

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the September 4, 2003, office action, reconsideration of the outstanding office action is respectfully requested.

Applicants again request withdrawal of the restriction requirement as between HopPtoA (SEQ ID NO: 7) and HopPtoA2 (SEQ ID NO: 66). Applicants demonstrated in the prior response (submitted April 17, 2003) that HopPtoA and HopPtoA2 are structurally and functionally similar (citing to Badel et al., "A Gene in the *Pseudomonas syringae* pv. *tomato* Hrp Pathogenicity Island Conserved Effector Locus, *hopPtoA1*, Contributes to Efficient Formation of Bacterial Colonies in Planta and Is Duplicated Elsewhere in the Genome," *MPMI* 15(10):1014-1024 (2002)). Despite the evidence introduced, the U.S. Patent and Trademark Office ("PTO") maintains—in contradiction to the evidence of record—that the two proteins have *different* functions. Because the PTO's position is incorrect and unsupported by evidence of record, applicants respectfully request that the restriction between these two structurally and functionally similar proteins should be withdrawn.

Applicants submit herewith a copy of the previously submitted supplemental information disclosure statement (dated February 13, 2003), along with its accompanying postcard (which indicates receipt thereof), and duplicate copies of the seven non-patent references identified therein. Should PTO again lose the references, applicants respectfully request that the examiner contact the undersigned rather than return an unsigned PTO-1449 form. Because applicants timely submitted these references before a first office action on the merits, no fee is enclosed.

The rejection of claims 7-9, 38-42, 44 and 45 under 35 U.S.C. §103(a) for obviousness over GenBank Accession No. AAF71504 ("AAF71504") in view of U.S. Patent No. 5,939,601 to Klessig et al. ("Klessig") is respectfully traversed.

AAF71504 discloses the amino acid sequence of a protein identified in the present application as HopPtoA (SEQ ID NO: 7).

Klessig teaches the amino acid sequence of a *Nicotiana* myb oncogene homolog designed as Myb1. The PTO cites to Klessig merely for teaching hybridization conditions similar to those claimed, as well as the purification of recombinantly expressed proteins.

Applicants submit that the rejection is improper because AAF71504 is not available as prior art and Klessig fails to teach or suggest each and every limitation of the claimed invention. Because AAF71504 was not publicly disclosed more than one year before applicants' April 3, 2000, priority date, AAF71504 is not available as prior art under 35 U.S.C. § 102(b). Moreover, AAF71504 does not evidence knowledge or use by others in this country prior to applicants' date of invention. As evidenced by the accompanying Declaration of James R. Alfano Under 37 C.F.R. § 1.132, the subject matter submitted to Genbank and now available as AAF71504 was submitted by him on behalf of him and his co-inventors. As such, AAF71504 does not constitute knowledge or use by others and, therefore, is not available as prior art under 35 U.S.C. § 102(a). Because Klessig fails to teach or suggest each and every limitation of the presently claimed invention, Klessig alone would have failed to have rendered the claimed invention obvious.

For these reasons, the rejection of claims 7-9, 38-42, 44 and 45 for obviousness over AAF71504 in view of Klessig is improper and should be withdrawn.

The rejection of claims 7-9 and 44 under 35 U.S.C. §103(a) for obviousness over AAF71504 in view of U.S. Patent No. 6,066,451 to Avraham et al. ("Avraham") is respectfully traversed. The teachings of AAF71504 are set forth above.

Avraham teaches the amino acid sequence for a human protein designated RR/B, which is a neural cell marker. The PTO cites to Avraham merely for teaching hybridization conditions similar to those claimed, as well as the purification of recombinantly expressed proteins.

Applicants submit that the rejection is improper because AAF71504 is not available as prior art and Avraham fails to teach or suggest each and every limitation of the presently claimed invention. For the reasons noted above, AAF71504 is not available as prior art under either 35 U.S.C. §§ 102(a) or 102(b). Because Avraham fails to teach or suggest each and every limitation of the presently claimed invention, Avraham alone would have failed to have rendered the claimed invention obvious. For these reasons, the rejection of claims 7-9 and 44 for obviousness over AAF71504 in view of Avraham is improper and should be withdrawn.

In view of all of the foregoing, applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

Date: October 31, 2003

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450, on the date below.

10/31/03
Date

Wendy L. Barry